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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/617,380	07/17/2000	DAVID J. OTWAY	CTX-052-(154	8636
21323	7590	09/24/2004	EXAMINER	
TESTA, HURWITZ & THIBEAULT, LLP HIGH STREET TOWER 125 HIGH STREET BOSTON, MA 02110			HENEGHAN, MATTHEW E	
			ART UNIT	PAPER NUMBER
			2134	

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/617,380	Applicant(s) OTWAY ET AL.	
	Examiner Matthew Heneghan	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
 4a) Of the above claim(s) 49-71 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-48 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-29 is/are rejected.
- 7) ☒ Claim(s) 8 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/8/00, 5/6/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of the restriction requirement in the reply filed on 4 May 2004 is acknowledged. The traversal is on the grounds that the prosecution of the additional group would not create a serious burden on the Examiner. This is not found persuasive because the additional group requires additional searching for prior art, as the claims of the non-elected group teach to a system having no third system participating in the transaction, yielding a protocol that is distinct from the claims of the elected group.

A search with respect to the non-elected group would require, for example, a complete search of Class 713/169 (mutual entity authentication); in the case of the elected group, a search of that class was made using the word "trusted" as a filter, since any system not having a trusted third party would not be relevant to the search.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 49-71 are withdrawn. Claims 1-48 have been examined.

Information Disclosure Statement

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3. Information Disclosure Statements filed on 4 May 2004 and 6 May 2004 that appear to be duplicates were found in the file wrapper. The statement filed on 4 May 2004 is therefore being ignored.

4. The following Information Disclosure Statements in the instant application have been fully considered, except as noted below:

IDS filed 8 September 2000.

IDS filed 6 May 2004.

5. Item CG is the IDS filed 8 September 2000 was illegible, and therefore not considered.

6. Items B10 and B12 in the IDS filed 6 May 2004 were not in English, and therefore not considered.

Specification

7. The abstract of the disclosure is objected to because it is not a single paragraph. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-7 and 10-20 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are:

In claim 1, no step specifies how the "first indicia" recited in the first step is used.

In claim 11, no step specifies how the "third indicia" is obtained or used.

In claim 17, it is not specified from where the second device gets the third key.

Claims 2-7, 10, 12-16, and 18-20 depend from rejected claims 1, 11, and 17 and include all the limitations of those claims, thereby rendering those dependent claims incomplete.

9. Claims 21-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 recites the limitation "said second encrypted key" in the last limitation. There is insufficient antecedent basis for this limitation in the claim. For purposes of the prior art search, it is being presumed to mean "said second message."

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Claim 27 recites the limitation "said second key of said third message" in the last limitation. There is insufficient antecedent basis for this limitation in the claim. For purposes of the prior art search, it is being presumed to claim 27 depends on claim 26.

Claim 29 recites the limitation "said third message" in the last limitation. There is insufficient antecedent basis for this limitation in the claim. For purposes of the prior art search, it is being presumed to claim 29 depends on claim 25.

Claims 22-26, and 28 depend from rejected claim 21 and include all the limitations of that claim, thereby rendering those dependent claims indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 17, 21-23, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,553,139 to Ross et al. (hereinafter "Ross I") and U.S. Patent No. 5,553,143 to Ross et al. (hereinafter "Ross II").

As per claim 17, Ross I discloses a distribution system for distributing software licenses. Ross I includes an embodiment wherein the licenses

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distributed are those disclosed in Ross II (see Ross I, column 3, lines 6-13; Ross II was filed as Application 08/192,166). Ross I transmits a license that includes key information (the first key) sent in a header (see Ross II, column 17, lines 31-42), where the license is encrypted using an enabler key (the second key). The enabler key is also transmitted in encrypted form to an extractor, which extracts the enabler key and subsequently transmits it to an installer (see Ross I, column 3, lines 14-44).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,553,139 to Ross et al. (hereinafter "Ross I") and U.S. Patent No. 5,553,143 to Ross et al. (hereinafter "Ross II"). as applied to claim 21 above, and further in view of Schneier, "Applied Cryptography," 1996, p.48.

Ross I and Ross II do not disclose the key protocol used in encrypting the enabler key being sent to the extractor.

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Schneier disclose the use of public key algorithms for key exchanging , and further suggests that this allow a system ("Alice") to send a secure message to another system ("Bob"), even if he has never heard of her.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to send the enabler key using a public key, as disclosed by Schneier, as this allows the system to send a key, even if the recipient has never heard of the sender.

Allowable Subject Matter

12. Claims 30-48 are allowed.

13. Claims 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Claim 1 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

15. Claims 2-7, 10-16, 18-20, and 26-29 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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16. The following is a statement of reasons for the indication of allowable subject matter: Regarding claims 1, 18, 26, and 30, no art could be found that would suggest the transmitting of the second key/authentication number encrypted by the first key/authentication number in order to complete an authentication.

Claims 2-16, 19, 20, 27-29, and 31-45 would be allowable based upon their dependence on allowable claims.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,400,403 to Fahn et al. discloses a system for broadcast key distribution.

U.S. Patent No. 5,440,635 to Bellovin et al. discloses a three-way authentication protocol.

U.S. Patent No. 5,553,145 to Micali discloses a system for transmitting messages using a trusted third party.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (703) 305-7727. The examiner can normally be reached on Monday,

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Tuesday, Thursday, and Friday from 8:30 AM - 4:30 PM Eastern Time. Beginning in October 2004, the telephone number is being changed to (571) 272-3834.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached on (703) 308-4789 (beginning in October, (571) 272-3838).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(703) 872-9306


Until October, hand-delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive, Arlington, VA 22202, Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900 (beginning in October, (571) 272-2100).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

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MEH 

September 17, 2004